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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,589	10/06/2003	Jonathan S. Spirgel	201818-0315425	5250

909 7590 10/29/2010  
PILLSBURY WINTHROP SHAW PITTMAN, LLP  
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MCLEAN, VA 22102

EXAMINER
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FIELDS, BENJAMIN S

ART UNIT	PAPER NUMBER
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3684

NOTIFICATION DATE	DELIVERY MODE
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10/29/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/680,589	<b>Applicant(s)</b> SPIRGEL ET AL.	
	<b>Examiner</b> BENJAMIN S. FIELDS	<b>Art Unit</b> 3684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 73-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 73-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Introduction***

1. The following is a **FINAL** Office Action in response to the communication received on 3 August 2010. Claims 73-88 are now pending in this application.

### ***Response to Amendments***

2. The Examiner acknowledges the Applicants comments and remarks regarding the Personal Interview held 28 June 2010

3. The Examiner acknowledges the Applicants comments, remarks, and cancellation of Claims 1-70. As such, the Examiner removes the originally asserted 35 U.S.C. 101 Rejection of Claims 1-70.

4. Applicants Amendments to Claims 1-72 has been acknowledged in that: **Claims 1-72 have been newly cancelled; NO Claims have been newly amended; Claims 73-88 have been newly added;** hence, as such, **Claims 73-88 are pending within this application.**

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 73-76, 78-79, and 85-88 are rejected under 35 U.S.C. 102(b) as being anticipated by SHERYL JEAN, [hereinafter Exhibit U].

EXHIBIT	DESCRIPTION
U	SHERYL JEAN Journal-Bulletin Business Writer. (1989, November 5). Silver is a good buy but may be quite risky. <i>Providence Journal</i> , p. F-08. Retrieved October 25, 2010, from Business Dateline. (Document ID: 596861821).

Referring to Claims 73 and 87-88: Exhibit U discusses a method for electronically trading shares of physical gold bars over an electronic communications network (ECN), the method comprising: providing an amount of the physical gold bars to a trust, the physical gold bars provided to the trust having a value based at least on a weight thereof (Exhibit U: Abstract; Paragraphs 1-10); receiving a number of trust shares each representing a proportional ownership interest in the physical gold bars (Exhibit U: Paragraphs 1-10); and using the electronic communication network (ECN) to trade one or more of the trust shares (Exhibit U: Paragraphs 1-10).

Referring to Claim 74: Exhibit U shows a method, wherein, after using the ECN to trade said one or more of the trust shares over the ECN, a buyer thereof owns a corresponding interest in a portion of the physical gold bars, said portion of the gold bars being stored in a repository associated with the trust account (Exhibit U: Abstract; Paragraphs 1-10).

Referring to Claim 75: Exhibit U discloses a method, wherein, after using the ECN to trade said one or more of the trust shares over the ECN, a buyer thereof owns a corresponding interest in a portion of the physical gold bars, said portion of the gold bars being physically transferred out of a repository associated with the trust account (Exhibit U: Abstract; Please see entire article).

Referring to Claim 76: Exhibit U teaches a method, wherein said using the ECN to trade one or more of the trust shares over the ECN comprises trading via a securities exchange so as to create a secondary market for the trust shares (Exhibit U: Abstract; Please see entire article).

Referring to Claim 78: Exhibit U discusses a method further comprising establishing the value of the physical gold bars by use of an assay result of the gold bars in addition to the weight (Exhibit U: Please see entire article).

Referring to Claim 79: Exhibit U shows a method further comprising maintaining the trust for the benefit of one or more trust share owners by a trustee (Exhibit U: Paragraphs 1-10).

Referring to Claim 85: Exhibit U discloses a method further comprising obtaining a receipt for the transferred physical amount (Exhibit U: Abstract; Please see entire article).

Referring to Claim 86: Exhibit U teaches a method further comprising creating additional trust shares responsive to a delivery of an additional physical amount of gold bars to the trust (Exhibit U: Abstract; Please see entire article).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 77, and 80-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Exhibit U in view of Official Notice.

Referring to Claim 77: Exhibit U shows the limitations of Claim 73.

Exhibit U, however, does not expressly show a method, wherein the securities exchange is the New York Stock Exchange.

The Examiner notes that Exhibit U does not expressly utilize a method, wherein the securities exchange is the New York Stock Exchange. It should be noted, however, that although Exhibit U does not expressly show a method, wherein the securities exchange is the New York Stock Exchange it would be an obvious teaching to allow such a system where the securities exchange is the New York Stock Exchange

because it is a readily known practice to buy, trade, and sell/exchange securities via the New York Stock Exchange.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the system and method of Exhibit U for the exchange of silver/gold wherein the securities exchange is the New York Stock Exchange because it is a readily known practice to buy, trade, and sell/exchange securities via the New York Stock Exchange.

Referring to Claim 80: Exhibit U discusses the limitations of Claim 73.

Exhibit U, however, does not expressly utilize a method further comprising, establishing a creation order that requests creation of the trust shares.

The Examiner notes that Exhibit U does not expressly utilize a method further comprising, establishing a creation order that requests creation of the trust shares. It should be noted, however, that although Exhibit U does not expressly show a method further comprising, establishing a creation order that requests creation of the trust shares, the obvious teaching of such is evident in that Exhibit U discusses a system and method which is responsible for the usage/creation of such commodities (See Exhibit U at least at Abstract; Paragraphs 1-10).

Referring to Claim 81: Exhibit U teaches the limitations of Claim 73.

Exhibit U, however, does not expressly utilize the term "creation order".

The Examiner notes that Exhibit U does not expressly utilize the term "creation order". It should be noted, however, that although Exhibit U does not expressly utilize the term "creation order", establishing a creation order that requests creation of the trust

shares, the obvious teaching of such is evident in that Exhibit U discusses a system and method which is responsible for the usage/creation of such commodities (See Exhibit U at least at Abstract; Paragraphs 1-10).

Referring to Claim 82: Exhibit U discusses the limitations of Claim 73.

Exhibit U, however, does not expressly utilize the term “creation order”.

The Examiner notes that Exhibit U does not expressly utilize the term “creation order”. It should be noted, however, that although Exhibit U does not expressly utilize the term “creation order”, establishing a creation order that requests creation of the trust shares, the obvious teaching of such is evident in that Exhibit U discusses a system and method which is responsible for the usage/creation of such commodities (See Exhibit U at least at Abstract; Paragraphs 1-10).

Referring to Claim 83: Exhibit U shows the limitations of Claim 73.

Exhibit U, however, does not expressly utilize the term “creation order”.

The Examiner notes that Exhibit U does not expressly utilize the term “creation order”. It should be noted, however, that although Exhibit U does not expressly utilize the term “creation order”, establishing a creation order that requests creation of the trust shares, the obvious teaching of such is evident in that Exhibit U discusses a system and method which is responsible for the usage/creation of such commodities (See Exhibit U at least at Abstract; Paragraphs 1-10).

Referring to Claim 84: Exhibit U discloses the limitations of Claim 73.

Exhibit U, however, does not expressly utilize the term “redemption order”.



The Examiner notes that Exhibit U does not expressly utilize the term “redemption order”. It should be noted, however, that although Exhibit U does not expressly show the term “redemption order”, the obvious teaching of such is evident in that Exhibit U discusses a system and method which is responsible for the purchasing of and exchanging of commodities to receive a final value (See Exhibit U at least at Paragraphs 1-10).

### ***Response to Arguments***

9. Applicants arguments filed 3 August 2010 have been fully considered but have been found to be **moot** and **non-persuasive** in view of the **new grounds of rejection** presented herein.

### ***Conclusion***

10. Applicants amendment necessitated the new grounds of rejection presented herein. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached MONDAY THRU FRI between the hours of 9AM and 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached at 571.272.6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas Dixon/

Primary Examiner, Art Unit 3684

Benjamin S. Fields

25 October 2010